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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/370,663	08/06/99	ABELOW	D 03058/004005

EXAMINER	
DIXON T	
ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/370,663	Applicant(s) ABELOW, DANIEL H.	
	Examiner Thomas A. Dixon	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 October 2000* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *48-51 and 53-63* is/are pending in the application.

4a) Of the above claim(s) *52 and 64-70* is/are withdrawn from consideration.

5)☒ Claim(s) *48-51,53-58 and 60-63* is/are allowed.

6)☒ Claim(s) *59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☒ The proposed drawing correction filed on *20 March 2000* is: a)☒ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other: .

DETAILED ACTION

1. Claims 48-51,53-63 remain. Claims 52, 64-70 have been cancelled.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged and is acceptable.***Response to Arguments***

3. Applicant's arguments filed 10 October 2000 have been fully considered but they are not persuasive.

Specifically, as per Claim 59 which was rejected under 112 2nd as being indefinite because it was unclear how the telephone keypad of line 4 is part of the television of claim 10, from which it depends. The language of Claim 48 lines 4-8 requires that the two-way interface be part of the commodity. If the commodity is a television, then the keypad or remote must be associated with the television, not a separate unit such as a set top box or a telephone keypad, which are well known in the art, see Von Kohorn (5,227,874). Applicant states that such structure was deliberately omitted to not further limit the invention. This is seen to be a claim similar to claim 52, which was objected under 37 CFR 17c as not further limiting the subject matter of the claims from which it depends. And as stated in that rejection, the medium for two-way interaction cannot be both part of the commodity, as required by claim 48, and not part of the commodity.

4. Claim 59 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 48, line 4 states "a

user interface which is part of each of the two-way units..." while claim 59 states "receiving answers from the user expressed through a keypad, a hand-held remote or a telephone keypad." The user interface cannot be both part of the unit, as the keypad or remote which are a part of the television, as required by claim 48 and not part of the unit, as a telephone keypad.

5. Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the telephone keypad of line 4, is part of the television of claim 57 from which it depends.

6. Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the relationship between the user interface which is part of each of the units of the commodity, in this claim a television, and a telephone keypad, which is obviously part of a telephone and not a part of a television..

Terminal Disclaimer

7. The terminal disclaimer filed on 10 October 2000 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 5,999,908 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Allowable Subject Matter

8. Claims 48-51,53-58,60-63 are allowable over the prior art of record, specifically Benton et al (4,625,276) in view of Palmer (5,438,355) further in view of Watanabe et al (4,905,080) further in view of Chiang et al (5,442,759).

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Von Kohorn (4,876,592) teaches keypad or telephone response to television program prompting, but does not disclose all the limitations of the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Friday 7 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 305-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

TAD
December 18, 2000

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100